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EXAMINER				
UBER, NATHAN C				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/568,753

Applicant(s)

MEBRUER, ROBERT

Examiner

NATHAN C. UBER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10 and 11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6, 8, 10 and 11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-856)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 22 March 2010.
2. Claim 1 has been amended.
3. Claims 1-6, 8, 10 and 11 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-6, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millikan (U.S. 2003/0105667) in view of Williams (U.S. 2002/0049631 A1).

Claim 1:

Millikan, as shown, discloses the following limitations:

- *a plurality of retail locations each having a detection device configured to detect data uniquely related to consumer, in proximity to a specific location where merchandise is available to the detected consumer, without requiring interaction by the detected consumer* (see at least ¶0024, "...a consumer detection and/or identification system...", "...the consumer does not need to

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do an activity to be detected by the system;" see also at least ¶0021, a retail store; see also at least ¶0027, retrieving unique customer data),

- *a first processor configured to generate a plurality of available offers and for identifying in a list specific offers in said plurality of offers that are applicable to a detected consumer based on data stored in a database relating to characteristics of the detected consumer, so that from the plurality of available offers, those specific offers, which relate to the detected consumer based on characteristics of the detected consumer are assembled for presentation as offers specific to the individual consumer* (see at least Figure 16, Item 20; see also at least ¶0029, generating targeted advertisements based on the characteristics of the customers identified/detected; see also at least ¶0028 providing individual targeted offers on an individual basis; Examiner notes that in the context of a system, this limitation is directed to a processors *for* accomplishing a task, *so that* a result may occur; hardware components having particular configurations carry patentable weight in system claims, however the intended use of systems or system components do not carry patentable weight in system claims; Examiner has demonstrated where in the prior art Applicant's claimed result is taught, however Examiner recommends that Applicant amend the claim language *so that* the entire limitation carries patentable weight and patentably affects the scope of the claim),
- *an output device configured to supply a single message specific to the individual detected consumer, providing specific offers available to the individual detected consumer at said location in relation to potential purchases at the specific location* (see at least ¶0033, a PDA or the like possessed by the consumer may receive the offers via a wireless configuration, Examiner notes that the offers and advertisements presented by the Millikan invention are *specific* to the store/location see at least ¶0029,

further Millikan discloses that "the message targeting system may perform its operation as described herein with respect to an individual consumer" see at least ¶0028),

- *whereby the detected consumers is able to receive offers at the specific location without physical interaction on his or her part, and to avail himself or herself of the offers contained in the message supplied at the location (see at least ¶0026, "...system does not require active participation by the consumer..."),*

With respect to the limitation *a single message*, Millikan does not specifically disclose a single message comprising the targeted offers, although Millikan certainly discloses transmitting a message to a customer via a wireless communication medium as noted in the rejection above. Further Williams discloses a similar system for providing offers to consumers wherein all available offers are provided to customer in a single communication at the POS machine (see at least ¶0057 and ¶0062). However, at ¶0024 Williams discloses that the electronic incentives need not be offered to a customer only at a time of sale and suggests several non limiting examples of how offers may be communicated to consumers including at ¶0034 a Kiosk. Thus, Williams teaches presenting consumer a single message comprising several offers available to the consumer, and when combined with the teaching of Millikan disclosing sending messages including offers to individual customers to a PDA, the combination fully teaches the above limitation. Millikan also does not specifically disclose the following limitations. However, Williams, as shown, discloses the following limitations:

- *a central station, comprising a second processor in communication with the first processor in each of said retail locations and configured to develop for each individual detected consumer a target file of said offers specific to the individual detected consumer and to provide said target file to at least said first processor (see at least figure 1, item, 46; see also at least ¶0033, central*

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system in communication with retail servers that generates specific offers for specific customers identified at the retail location),

- *the first processor comprises a first server configured to receive the target file of offers (see at least figure 1 and ¶0033, IIS),*
- *a second server associated with the location being connected to the first server (see at least figure 1 and ¶0033, CIS),*
- *an Electronic Point of Sale (EPOS) terminal connected with the second server so that offers supplied by said message to a particular consumer at the specific location are also transmitted from the first server to the second server and then to the EPOS terminal at that same location to condition the EPOS terminal such when a consumer identifies himself or herself at the EPOS terminal, purchases made by the consumer are priced at the EPOS terminal in accordance with said offers specific to and previously supplied to that consumer at said location without any responsive action by the detected consumer prior to presentation at the EPOS terminal other than carriage of goods for purchase to the EPOS terminal (see at least figure 1 and ¶0049, POS receives offer data from CIS and is available to the customer when the customer identifies him/herself at the POS to purchase qualifying items; see also at least ¶0021, no acceptance on the part of the customer prior to qualification is necessary, the customer may accept the offer by purchasing the qualifying product or service),*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the incentive offer processing and networking features of the Williams invention with the in-store offer advertising system of Millikan since Williams specifically discloses that the Williams invention is designed to be implemented with any communication equipment and information processing equipment already in-place in retail environments (see ¶0045) and since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the

same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 2:

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *said retail location is a retail outlet, a mall, a food court or an event area (see at least ¶0021, "...establishment... such as a retail store...").*

Claim 3:

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the detection device comprises a Radio Frequency Identification Device (RFID) reader for reading an RFID tag carried by the consumer to identify a particular consumer (see at least ¶0024, "...detection... system may be a... field generator/detector that is operative to detect an identification card such as a transponder type card or a smart card...", RFID readers are Inherent to smart card and transponder technology).*

Claim 4:

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the RFID tag can provide a unique code which provides a unique identification of an individual consumer so that individual consumers can be identified and distinguished from one another (see at least ¶0024, "...card may include the consumer information thereon, or provide consumer identification data...").*

Claim 5:

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the RFID tag is contained in a card carried by the consumer* (see at least ¶0024, "...an identification card such as a transponder type card or a smart card...").

Claim 6:

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the output device comprises a transmitter* (see at least ¶0027, "...a message generator and transmitter..."),
- *for wireless transmission of the message to the individual consumer's mobile telephone or other portable receiver* (see at least ¶0033, "...a wireless configuration... a PDA or the like...").

Claim 8:

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further Williams, as shown, discloses the following limitation:

- *output device is a printer for printing a document containing the offer* (see at least ¶0022, the benefit may be a printed coupon printed at the POS machine; see also at least ¶¶0057 and 0062, multiple benefits supplied simultaneously to consumer at EPOS),

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the features of the Williams invention with the in-store offer advertising system of Millikan since Williams specifically discloses that the Williams invention is designed to be implemented with any communication equipment and information processing equipment already in-place in retail environments (see ¶0045) and since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 11:

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Further both Millikan and Williams, as shown, disclose the following limitations:

- *the consumer identifies himself or herself by displaying the message to a person at the EPOS terminal, or by swiping a card which contains the user's identifying data at the EPOS terminal (see at least Millikan ¶0032, "...swiping of the customer card..."; see also at least Williams ¶0067, POS system IDs customer via a variety of ID cards).*

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Millikan (U.S. 2003/0105667) in view of Williams (U.S. 2002/0049631 A1) and in view of Eggleston et al. (U.S. 6,061,660).

Claim 10:

The combination Millikan/Williams discloses the limitations as shown in the rejection above. Millikan, as shown discloses the following limitations:

- *a retail server, a consumer data base in communication with each of said first processor and said second processor, and operative to provide and consumer data for processing by said first and second processors (see at least ¶0027, storage medium for storing customer data and providing the customer data to the system for generating targeted offers; see also at least ¶0028),*

Millikan does not specifically disclose the following limitation. However, Eggleston, as shown discloses the following limitation:

- *comprising an inventory system in communication with each of said first processor and said second processor, and operative to provide price and inventory for processing by said first and second processors (see at least column 39, lines 12-21, a retailer inventory system is made available to the promotion system so that the promotion system can coordinate inventive with the products available/in inventory at the retailer),*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the feature described in the Eggleston invention of polling the retailer's inventory system to coordinate the provision of incentives with the Millikan/Williams inventions that similarly utilize computing technologies in communication over disparate networks since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

8. Applicant's arguments filed 22 March 2010 have been fully considered but they are not persuasive. As a initial matter, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
9. Applicant first argues against the Millikan reference citing Millikan's alleged failure to teach transmission of a single message, to a consumer detected in a store and sending the information to a POS machine. Both limitations were taught by the combination of references as noted in the rejection above. Further, as previously noted of while Examiner relies on Williams to teach the claimed "single message," Examiner maintains that Millikan discloses detecting customers (see at least ¶0024) transmitting offers to "an individual customer" in at least ¶0028 in which Millikan discloses "[w]hile the message targeting system may perform its operation as described herein with respect to an individual consumer..." and in at least ¶0033 in which Millikan discloses "[w]hile not specifically shown, a PDA or the like either owned by the consumer or provided by the establishment may also be used on a wireless basis" for the receipt of offers targeted to the consumer by the message targeting system. Applicant apparently dismisses this teaching in Applicant's argument and defaults to the argument that the Millikan invention seeks to protect a customer's privacy by presenting an advertisement mix that targets the population in the store

(see page 6 of Applicant's remarks). Examiner maintains however, that despite these ambitions as noted in Millikan, Millikan nevertheless teaches generating individually targeted advertisements and chooses (in the preferred embodiment) not to use them in the same manner as Applicant claims. However, as noted, Millikan teaches presenting advertisements to users individually. Applicant's argument focus only on the preferred embodiment of the Millikan invention and apparently ignores the full scope of the teachings presented in the combination of references above is not persuasive. The combination of references fully discloses and renders obvious Applicant's claimed invention as noted in the rejections above.

10. With regard to the Williams reference, Applicant argues that Williams does not disclose transmission of a single offer to a consumer and "only then" transmitting the ad information to the POS terminal. Applicant argues that Applicant's invention is distinguishable from the Williams teachings because the POS machine is only apprised of applicable discounts at the location where the customer is detected and only when the offers are transmitted to the customer. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the transmission of data to the POS "only" at certain times or after certain other events occur) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (Examiner notes that Examiner cannot find the "only when" limitations from Applicant's arguments in the specification either). See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Williams is relied on to teach the single offer message limitation, and transmitting offers to the customer and the POS so that a customer need only present the offered item at the POS to receive the benefit of the offer. The other limitations of the claims with regard to targeting and identifying the customer are taught by Millikan. The combination of references teaches all of the limitations of Applicants claims and renders Applicant's claims obvious.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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13. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
15. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

16. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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401 Dulany Street
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
15 June 2010

/Arthur Duran/
Primary Examiner, Art Unit 3622